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Alexandria, VA 22313-1450

## **REPLY TO EXAMINER'S ANSWER**

### **First Ground of Rejection**

Claims 1, 2, 5, 6 and 9-16 stand finally rejected under 35 U.S.C. § 102(a) as being anticipated by Adams (U.S. Patent 6,718,470). Appellants traverse this rejection for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

#### **Claims 1, 2 and 16:**

Regarding claim 1, Appellants have argued that **Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service.** Appellants have argued that Adams teaches that any matching attribute certificates are sent as privilege data (Adams, column 6, lines 65-67). The certificates in Adams do not indicate that a client has the right to use *only* a portion that is less than all of a service's provided capabilities. No mention is made in Adams of allowing access to only a portion of a service's capabilities. Please refer to Appellants Appeal Brief for a more detailed discussion of Adams' teachings.

In the Response to Arguments the Examiner cites column 5, lines 14-17 and lines 38-41 as well as column 6, lines 49-65, referring to Adams' teachings regarding a subscriber communicating a request for another application controlled by a relying party and regarding a certificate selector analyzing a subscriber's attribute certificates to determine whether any of them contain privilege data that is consistent with privilege test criteria. However, as argued previously **the teachings of Adams relied on by the Examiner do not disclose a client receiving a capability credential that indicates that the client has the right to use *only a portion* of a service's capabilities, wherein *the portion is less than a total of the capabilities* provided by the first service.** Instead, the Examiner's cited passage describes a particular manner in which Adams' system

determines whether the subscriber certificates, such as data representing a subscriber unit's privilege status, meet the particular required privilege test criteria data.

Appellants have also argued that Adams teaches that privilege test criteria data indicates "the specific privilege information necessary for the relying party to grant privilege to a subscriber unit" (Adams, column 3, lines 47-51). In the Response to Arguments, the Examiner states that Adams "pre-qualification privilege data sent to subscriber indicates the limited capabilities that a subscriber is entitled to with respect to all of the services provided by the relying party." However, the portions of Adams relied on by the Examiner are not referring to a capability credential indicating that a client has the right to use only a portion of a services capabilities. Instead, the cited portions of Adams are teaching a particular method of determining whether a subscriber's privilege status meets the particular privilege requirements of a relying unit. As noted above, the certificates in Adams do not indicate that a client has the right to use *only* a portion of a service's capabilities. In fact, Adams makes no mention regarding allowing access to only a portion of a service's capabilities wherein the portion is less than a total of the capabilities provided by the service.

**In the Response to Arguments**, the Examiner also argues, "the privilege data returned by the selector entity indicates that the user has the right to use only certain portion of the service's capabilities." **However, the Examiner's interpretation of Adams is incorrect.** Adams' system determines whether subscriber certificates meet particular test criteria data. In other words, Adams' teaches that a subscriber's certificates are verified to ensure that the particular type of certificate is an approved type. For example, Adams teaches that the privilege test criteria data may indicate the specific privilege information necessary for the relying part to grant privilege to the subscriber unit. The Examiner is merely speculating in hindsight regarding Adams' system. As noted above, nowhere does Adams make any mention whatsoever of a client receiving a capability credential that indicates that the client has the right to use *only a portion* of a service's capabilities, wherein *the portion is less than a total of the capabilities* provided by the first service.

Appellants have also argued that Adams is not concerned with granting a client rights to use only a portion of a service's capabilities. Instead, Adams is concerned with minimizing the number of certificates that must be transferred and also with preventing privilege data from being sent to non-privilege parties (Adams, column 2, lines 58-61 and column 3, lines 41-44). Adams contrasts his systems with previous systems that require the subscriber to present all attribute certificates to the relying party.

**Claim 5:**

Appellants have argued that Adams fails to disclose the client receiving an advertisement for the first service, wherein the advertisement describes the portion of the first service's capabilities. The Examiner admits that Adams makes "no specific mention of the advertisement" but asserts, "advertisement serves as a way of letting the user be aware of the service[s] available." The Examiner has clearly failed to provide a proper rejection of claim 5. By admitting that Adams does not disclose the use of an advertisement, the Examiner has clearly admitted that Adams fails to anticipate claim 5. Please refer to Appellants Appeal Brief for a more detailed discussion of the portion of Adams cited by the Examiner in the rejection of claim 5.

Thus, the Examiner is clearly relying on his own assumptions and speculations regarding how Adams' system might work. Since advertisement is disclosed by Adams, the Examiner relies on his belief that "advertisement serves as a way of letting the user be aware of the service[s] available." However, the Examiner's statement that advertisements *may* serve as a way of letting a user know what services are available has absolutely no bearing on the fact that Adams fails to disclose anything about an advertisement for a service that *describes a portion of the service's capabilities*. The fact that Adam's system might benefit from the use of such an advertisement, as suggested by the Examiner, is irrelevant to a rejection based on anticipation (i.e. § 102). The Examiner's statement is also unsupported by any evidence of record.

In the Response to Arguments, the Examiner does not cite any portion of Adams that discloses an advertisement as recited in Appellants claim. Instead, the Examiner argues that “advertisement achieved through the use of website is well known in the art” and that “subscribers are exposed to an advertisement when accessing a certain website and decided to request the service described in the advertisement.” However, once again the Examiner is merely making speculations (which is clearly improper) regarding the workings of Adams system.

As admitted by the Examiner, Adams fails to disclose the use of an advertisement that describes a portion of the service’s capabilities. Moreover, the Examiner has not shown that the use of advertisements is inherent in Adams’ system. “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence” and “[s]uch evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference” (emphasis added, M.P.E.P. § 2131.01 III). Instead, the Examiner merely repeats his own opinion that Adams’ system would include advertisements, since “the subscriber must be aware of the service provided by the relying party and the capability of that service prior to using it.”

Regardless of whether or not Adams’ subscribers must be aware of the service provided and the capability of that service prior to using it, the fact remains that Adams does not disclose the specific limitations of claim 5. As noted above and admitted by the Examiner, Adams makes no mention of advertisements, nor has the Examiner provided any evidence showing that advertisements are *necessarily present* in Adams’ system. Instead, the Examiner has merely concluded that the use of an advertisement might be beneficial, which as stated above, is completely speculative and irrelevant. The Examiner is merely using hindsight speculation, which is clearly improper.

In the Response to Arguments section of the Final Action and in the Advisory Action, the Examiner asserts that a subscriber request to access an application through Adams’ relying party’s website “indicates that the advertisement for certain services exist

as to enable a subscriber to request privilege to use such service”, citing column 5, lines 14 – 18 of Adams. The Examiner further asserts, “Adams inherently disclose[s] these limitation[s] as they are [an] essential requirement for a subscriber to request certain services provided by a relying party.” Thus, the Examiner’s argument is that the mere fact that a subscriber unit makes requests the use of a service inherently discloses the specific limitations of claim 5. Appellants have argued that even if Adams could be said to inherently disclose an advertisement, which Appellants maintain he does not, the Examiner has still failed to show how Adams’ system *inherently* includes a client receiving an advertisement that describes the portion of the service’s capabilities.

In further regard to claim 5, Appellants have also argued that **Adams fails to disclose that a client’s indication of the set of desired capabilities comprises an indication of the advertisement**. As noted above, Adams fails to mention anything about advertisements, as admitted by the Examiner. Furthermore, Adams does not mention anything about a client indicating a set of desired capabilities as part of requesting a capability credential, *where the indication of the set of desired capabilities includes an indication of an advertisement for a service*. As noted above, the Examiner has merely stated that the use of advertisements would be beneficial to Adams’ system without showing that Adams’ system actually includes the use of advertisements. The Examiner has not provided any argument, explanation, or evidence showing that Adams’ system includes a client indicating a set of desired capabilities, where that indication includes an indication of an advertisement for a service providing those capabilities.

The Examiner, in his Answer, states that “[w]ithout indicating the desired capabilities, the centralized privilege data selector will not be able to determine whether the capabilities associated with the subscriber are sufficient to access services provided by [the] relying party.” However, the Examiner is once again not relying on any specific teachings of the cited art, but instead merely relying on his own opinion and/or speculation. As noted previously, the Examiner has not provided any extrinsic evidence that Adams’ system necessarily includes a client receiving an advertisement for a service that describes a portion of the service’s capabilities. Moreover, M.P.E.P. 2112

IV states, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic” (underlining in original). The Examiner’s opinion that Adams’ system inherently includes the use of advertisements “as a way of letting the user be away of the service available” or “to enable a subscriber to request privilege to use such service” is incorrect and is not extrinsic evidence that makes clear that the use of advertisements as recited in Applicants’ claim 5 is necessarily present in Adams’ system.

Thus, for at least the reasons above, the rejection of claim 5 is not supported by the cited art and removal thereof is respectfully requested.

**Claim 6:**

Regarding claim 6, Appellants have argued that **Adams fails to disclose that the indication of the advertisement is the advertisement itself**. The Examiner, both in the rejection and in the Response to Arguments section of his Answer, cites column 5, lines 14-18. However, the cited portion of Adams makes no mention of any *indication of an advertisement*, nor that such an indication of an advertisement is the advertisement itself. Furthermore, in the rejection of claim 5, the Examiner admits that Adams makes no mention of advertisements. Please refer to Appellants’ Appeal Brief for a more detailed discussion of Adams’ system.

In the Response to Arguments of the Answer, the Examiner asserts that the use of advertisements is inherent in Adams’ system. Specifically, the Examiner states, by indicating the relying party’s identification, the indication of the advertisement is achieved since the advertisement is the website itself.” The Examiner is clearly incorrect. Nowhere does Adams teach that the website describes a service’s capabilities. In fact, the only mention in Adams teaches regarding the website states, “the subscriber unit 200 may communicate a request over a global network link to a Website of the relying party requesting access to another application controlled by the relying party to facilitate a financial transfer.” Please refer to the remarks above regarding claim 5 for a detailed

discussion regarding the fact that Adams' system does not inherently disclose the limitations of Applicants' claims.

Once again, the Examiner have failed to provide any extrinsic evidence, citation, explanation or interpretation illustrating that a subscriber unit's request *necessarily* indicates a set of desired capabilities that includes an indication of an advertisement (as recited in claim 5) where the indication of the advertisement is the advertisement itself, as recited in claim 6. Following the Examiner's line of reasoning (that the use of advertisements are inherent in Adams' system and that the website is the advertisement) a subscriber's request would also have to inherently *include the website itself*. Not only does this not make sense, there is nothing about Adams' system that inherently requires a subscriber unit to include a *website* as an advertisement (of which Adams makes no mention) in an indication of capabilities as part of requesting a capability credential. The Examiner's interpretation is clearly incorrect.

**Claim 9:**

Appellants have argued that **Adams does not disclose an advertisement that is a protected advertisement that describes the first service's capabilities but does not provide an interface to the first service's capabilities**. The Examiner cites column 5, lines 14-18 where Adams teaches that a subscriber unit may send a request message to a website of a relying party to request access to another application controlled by the relying party to facilitate a financial transfer. As noted above regarding the rejection of claim 6, the cited passage makes no mention of any advertisements of any kind.

In the Response to Arguments section of the Examiner's Answer, the Examiner cites column 5, lines 55 – 57 of Adams and refers to the fact that when verifying pre-qualification privilege data, Adams' verifier 106 may generate "[v]erification data 206 indicating a 'yes/no' result to accept the subscriber's privilege." Appellants fail to see the relevance of a yes/no result from verifying pre-qualification privilege data to an

advertisement being a protected advertisement that describes the service's capabilities but does not provide an interface to the first service's capabilities.

Firstly, Adams' data verifier 106 does not describe a service's capabilities nor provide an interface to the service's capabilities regardless of whether pre-qualification privilege data is verified or not. Secondly, the Examiner, regarding claims 6 and claim 5, from which claim 9 depends has already stated that he considered the website itself to be the advertisement (Response to Arguments regarding claims 5 and 6 in Examiner's Answer). Thus, according to the Examiner's logic, Adams' website would have to describe a service's capabilities but not provide an interface to the service's capabilities. The Examiner's interpretation is clearly incorrect. Adams website is clearly not equivalent to, nor does it disclose, the advertisement of Appellants' claims. Moreover, Adams' website clearly provides an interface to a service, and therefore, even under the Examiner's interpretation, Adams fails to anticipate claim 9.

#### **Claims 10, 11 and 12:**

Appellants have argued that Adams fails to disclose a client receiving a protected advertisement for the first service, wherein **the protected advertisement indicates an address for sending the capability credential request message to**. In the Response to Arguments section of the Examiner's Answer, The Examiner cites column 5, lines 14 – 18 and column 6, lines 31 – 49. However, neither of the cited passage makes any mention of a client receiving a protected advertisement that indicates an address to which to sending a capability credential request message. The first cited passage states that a subscriber unit may communicate a request over a global network link to a website of a relying party requesting access to another application controlled by the relying party to facilitate a financial transfer. The second cited passage describes a centralized privilege data selector that “selects among privilege data for a plurality of subscribers.”

The Examiner also states, in the Answer, that since “communication between each entity is through network communication, there must exist an identification for each

entity in order to initiate communication between entities” and that “[t]herefore, an address for sending request is required in the system of Adams.” Appellants agree that in order to send a request, the sender must know the address to which to send the request. However, simply because the address is required does not disclose the specific limitation of a *protected advertisement* indicating an address to send a capability credential request message to, as recited in Appellants’ claims. The Examiner is not rejecting Appellants’ claims based on the actual teachings of the cited art. Instead, the Examiner is relying upon his own opinion and speculation regarding how Adams’ system might work, despite no actual disclosure by Adams of those features relied upon by the Examiner. Since Adams is silent regarding a protected advertisement indicating an address for sending the capability credential request message to, Adams clearly fails to anticipate claim 10.

**Claim 13:**

Appellants have argued that Adams fails to disclose **a client receiving a protected advertisement for the first service, wherein said protected advertisement indicates an authentication service and wherein said requesting a capability credential comprises the client requesting a capability credential from the authentication service.** The Examiner cites column 5, lines 14 – 18 and 54-57 in the Response to Arguments section of the Examiner’s Answer. However, as described previously, neither of these cited passages makes any mention of any advertisement further fail to describe a protected advertisement that indicates an authentication service.

The Examiner also states in the Answer, “Adams discloses that a subscriber is allowed to understand what services the relying party provides but actual access to the service is granted after verification” referring to the fact that Adams’ service is an application controlled by the relying party. The Examiner then concludes, “[t]herefore, Adams clearly discloses the protected advertisement that describes services provided but not the actual service itself.” Appellants do not follow the Examiner’s logic. Just because a subscriber may be granted access to a service after verification does not have anything all to do with and certainly does not disclose the specific limitations of a

protected advertisement as recited in claim 13. Furthermore the Examiner has not explained how the fact that Adam's subscriber may be granted access to a service after verification has anything to do with a protected advertisement indicating an authentication service.

**Claim 14:**

Appellants have argued that **Adams fails to disclose the authentication service determining a level of the first service's capabilities that the client is authorized to use**. Specifically, Appellants have argued that while the Examiner's cited passage describes Adams' centralized privilege data selector, Adams' centralized privilege data selector does not have anything to do with determining a level of the service's capabilities that the client is authorized to use. As Adams states, a privilege data selector selects among a plurality of attribute certificates associated with a selected subscriber unit and that the privilege test criteria data may be generated by the relying party to indicate the specific privilege information necessary for the relying party to grant privilege to a subscriber unit (Adams, column 3, lines 44-51). In other words, the relying party indicates, by generating privilege test criteria data, what sort of privilege data is required to grant a subscriber unit privilege and the privilege data selector selects attribute certificates that match the test criteria data. Appellants argument is that Adams' centralized privilege data selector does not determine a level of a service's capabilities that a client is authorized to use. Instead, it merely determines which attribute certificates for a subscriber unit match the privilege test criteria data provided by the relying party.

In the Response to Arguments section of the Examiner's Answer, the Examiner argues that Adams' "pre-qualification privilege data sent by the centralized data selector to a subscriber contains a set of privileges that the subscriber possesses and only the set of privileges included in the pre-qualification privilege data can the subscriber use to access service provided by relying party" citing column 6, lines 58-67 of Adams. However, this portion of Adams does not describe determining a level of the service's capabilities that the client is authorized to use. Instead, the cited passage describes the

comparison of the subscriber's privilege data with the privilege test data to determine whether or not the subscriber holds a certificate of a type acceptable to the relying party. As shown previously, Adams teaches that certificates, such as Kerberos tickets, privilege attribute certificates, or other public key certificates (Adams, column 7, lines 48-55) may be selected from among multiple privilege data based on test criteria supplied by a relying unit (such as a software application, computer node or other entity). Thus, Adams teaches that the centralized data selector compares those certificates (privilege data) held by the subscriber to the type of certificates (privilege test criteria) acceptable to the relying party.

Adams does not disclose that the portion of a service's capabilities that a returned attribute certificate indicates that the subscriber unit has a right to use is *no more than* the set of desired capabilities. Adams teaches only that his privilege data selector returns attribute certificates that match a particular set of privilege criteria test data.

**Claim 15:**

Appellants have argued that Adams fails to disclose wherein the portion of the first service's capabilities that the capability credential indicates that the client has a right to use is the lesser of the level of the first service's capabilities that the client is authorized to use and the set of desired capabilities. In his Answer, the Examiner again cites column 6, lines 51 – 67, where Adams describes the centralized privilege data selector that returns attribute certificates that match privilege criteria test data. However, as shown previously, the cited passage does not describe that the attribute certificates indicate a portion of a service's capabilities that a client has a right to use as being the lesser of the level of the service's capabilities that the client is authorized to use and the set of desired capabilities.

The Examiner also states, in the Response to Arguments section of the Answer, the Examiner states, "the privilege data received by the subscriber is a subset of the total capabilities provided by the relying party because it is impossible to obtain capabilities of

a relying party for which the relying party does not provide.” The Examiner’s argument does not make any sense. The fact that it may be impossible to obtain capabilities that a relying party does not provide does not mean that in Adams’ system a subscriber always (as implied by the Examiner) receives a subset of the total capabilities provided by a relying party. Since Adams is silent regarding that **the portion of the first service’s capabilities that the capability credential indicates that the client has a right to use is the lesser of the level of the first service’s capabilities that the client is authorized to use and the set of desired capabilities**, Adams clearly fails to anticipate claim 15. In fact nowhere does Adams teach anything regarding this limitation of claim 15. The Examiner is merely speculating regarding the workings of Adams’ system, which is clearly improper.

### **Second Ground of Rejection**

Claims 3 and 7 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams. Appellants traverse this rejection for at least the reasons presented regarding their respective independent claims.

#### **Claim 7:**

Further regarding claim 7, Appellants have argued that the Examiner has failed to provide a proper motivation for modifying the system of Adams’ to use a URI. In the Answer, the Examiner states that it would have been obvious “to use URI to indicate the advertisement because URI is standard identifier for accessing a website or advertisement.” However, as admitted by the Examiner, Adams fails to mention anything about an advertisement. Furthermore, just because URI may be a “standard identifier for access a website” does not mean that one would be motivated to modify Adams. The Examiner has not provided any reasoning as to why one would modify Adams, as suggested by the Examiner.

Furthermore, claim 7 not merely recite some general use of a URI. Instead, claim 7 requires that the indication of the advertisement, which (as recited in claim 5) is comprised in an indication of the set of desired capabilities, is a URI to the advertisement that describes a portion of the first service's capabilities. Since, as shown above regarding claim 5, from which claim 7 depends, Adams fails to teach anything regarding an indication of a set of desired capabilities, the Examiner must also provide motivation to include such an indication and to include a URI to a website in that indication of desired capabilities, as required by claim 5 and claim 7. The Examiner has failed to do so.

Moreover, as noted in the M.P.E.P. at 2144.03, "it is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record". See, *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421. That is precisely the case here, the Examiner has merely stated that it would be obvious to modify Adams to use a URI to an advertisement (that is not even taught by Adams) because "URI is standard identifier for accessing a website or advertisement".

#### **Fourth Ground of Rejection**

The Examiner does not specifically address Appellants arguments regarding this ground of rejection. Instead, the Examiner refers to his response regarding the first rejection. Please refer to Appellants responses above for refutations of the Examiner's responses.

#### **Fifth Ground of Rejection**

The Examiner does not specifically address Appellants arguments regarding this ground of rejection. Instead, the Examiner refers to his response regarding the rejections of claims 3, 4, and 7. However, claims 17-23, 35-39 and 41-47 recite different subject matter than claims 3, 4 and 7.

Therefore, Appellants note that the Examiner has not responded to any of Appellants arguments regarding the § 103(a) rejection of claims 17-23, 25-39 and 41-47.

For example, the Examiner has failed to response to Appellants argument regarding the lack of a *prima facie* § 103(a) rejection of claims 17-23, 25-39 and 41-47. Appellants have argued that the Examiner has not met any of the three basic requirements of a proper § 103(a) rejection of claims 17 and 33. Furthermore, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” If the Examiner does not produce a *prima facie* case, “the applicant is under no obligation to submit evidence of nonobviousness.” (see, M.P.E.P. § 2142 and 2143).

Nor has the Examiner responded to Appellants argument regarding the deficiencies of Czerwinski in regard to independent claims 17 and 33 discussed in Applicants’ previously filed Appeal Brief from which the Examiner reopened prosecution with the current rejection. For the reasons stated above in regard to Adams and the reasons stated in the previous Appeal Brief in regard to Czerwinski, it is clear that neither Adams nor Czerwinski, alone or in combination, teaches or suggests all the limitations of independent claims 17 and 33. The Examiner has failed to respond to this argument at all.

## CONCLUSION

For the foregoing reasons submitted in the Appeal Brief and this Reply Brief, it is submitted that the Examiner's rejections of claims 1-47 is erroneous, and reversal of his decision is respectfully requested.

The Commissioner is authorized to charge any fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-70400/RCK. This Reply Brief is submitted with a return receipt postcard.

Respectfully submitted,

/Robert C. Kowert/

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